



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/791,996

03/03/2004

Carmen Flosbach

FA1013 US DIV

4286

23906 7590 02/12/2008
E I DU PONT DE NEMOURS AND COMPANY
LEGAL PATENT RECORDS CENTER
BARLEY MILL PLAZA 25/1122B
4417 LANCASTER PIKE
WILMINGTON, DE 19805

EXAMINER

TSOY, ELENA

ART UNIT

PAPER NUMBER

1792

NOTIFICATION DATE

DELIVERY MODE

02/12/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-Legal.PRC@usa.dupont.com

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/791,996 | Applicant(s) FLOSBACH ET AL. | |
| | Examiner Elena Tsoy | Art Unit 1792 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11, 12, 16 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11, 12, 16 and 19-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

Amendment filed on December 11, 2007 has been entered. Claims 11-12, 16, 19-21 are pending in the application.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 11, 12, 16, 19-21 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for the reasons of record set forth in paragraph 2 of the Office Action mailed on 9/10/2007.

Applicants state that Page 3 in the Specification, in fact, does list cycloaliphatic diols as well as aliphatic diols. Applicants reproduce the cited lines from Page 3 of the Specification below:

(L1) Examples of (cyclo)aliphatic diols as hydroxyl components (al) (L2) for the composition of the polyester (a) include ethylene glycol, 1,2- (L3) propylene glycol and 1,3-propylene glycol, butane-1,3-diol, butane-1,4-diol (L4) and butane-2,3-diol, pentane-1,5-diol, hexane-1,6-diol, trimethylhexane diol, (L5) diethylene glycol, triethylene glycol, **hydrogenated bisphenols**, 1,4- (L6) **cyclohexane dimethanol**, neopentyl glycol, butylethylpropane diol. Hexane- (L7) 1,6-diol, neopentyl glycol, butylethylpropane diol are preferred.

(L8) Examples of (cyclo)aliphatic polyols having 3 to 6 hydroxyl groups as (L9) hydroxyl components (al) for the composition of the polyester polyol (a) (L10) include glycerol, trimethylolpropane, trimethylolethane, pentaerythritol, (L11) dipentaerythritol, ditrimethylolpropane, sorbitol, mannitol. Glycerol, (L12) trimethylolpropane, and pentaerythritol are preferred, particularly (L13) trimethylolpropane, and pentaerythritol. (Emphasis added).

The Examiner respectfully disagrees with this argument. Claim 11 recites **(cyclo)aliphatic polyols having 3 to 6 hydroxyl groups NOT (cyclo)aliphatic *diols*.**

Art Unit: 1792

Therefore, the fact that the Specification does list cycloaliphatic *diols* as well as aliphatic *diols*, **is irrelevant** because all examples of (cyclo)aliphatic polyols having 3 to 6 hydroxyl groups (that are recited in claim 11) are disclosed at page 3 of the specification as being only **non-cyclic** aliphatic polyols. Therefore, in contrast to Applicants statement, the Applicants' specification does not disclose any examples of (cyclo)aliphatic polyols having 3 to 6 hydroxyl groups.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 11, 12, 16, 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duecoffre et al (US 6,063,448) for the reasons of record set forth in paragraph 4 of the Office Action mailed on 9/10/2007 because the Amendment does not change the scope of the invention.

Response to Arguments

5. Applicant's arguments filed December 11, 2007 have been fully considered but they are not persuasive.

(A) Applicants argue that the Examiner's position was that the polyester (b) of Duecoffre disclosed the Applicants' non-aromatic polyester (a) component of the coating composition used in Applicants process. Applicants have amended the claims in regard to the polyester (a) component to polyester consisting of "at least one cycloaliphatic polyol having 3 to 6 hydroxyl groups" and "at least one dicarboxylic acid". Applicants' polyester (a) has a high hydroxyl functionality from 4.5 to 10.

The Examiner respectfully disagrees with this argument. The Applicants' non-aromatic polyester (a) component is made from the same polycarboxylic acids as the polyester (b) of

Duecoffre, e.g. fumaric acids and dimeric fatty acids (See specification, page 3, line 28) and tri- and/or polyhydric alcohols such as glycerol, trimethylolpropane, pentaerythritol, dipentaerythritol (See specification, page 3, lines 10-11). Therefore, the polyester of Duecoffre would have the same high hydroxyl functionality from 4.5 to 10.

(B) Applicants state that the amendment to the claims for the (b) component of Applicants' composition is directed to components that are clearly outside of the hybrid polymers taught by Duecoffre. As has been previously pointed out, the hybrid polymers used in Duecoffre are different from a simple physical mixture of a (meth)acrylic copolymer and polyester polyol of Applicants' invention. Duecoffre's clear coat contains a hybrid binder comprising polyester polyol as one part, and the (meth)acrylic copolymer as the second part and a polyester which as pointed out above is not the polyester (a) of the composition used in Applicants' process.

The Examiner respectfully disagrees with this argument for the reasons discussed above.

(C) Applicants state that Duecoffre's polyesters are ordinarily known polyesters. The polyesters claimed in the present invention with the specific combination of limitations cannot be found in Duecoffre. Further, Applicants call the Examiner's attention to Example 1, in particular Table 1 (see page 10 of the specification). Six clear coating compositions were prepared. Composition 1-3 used a polyester polyol (b) only which is outside of the scope of amended Claims 11 and 12 and Compositions 4-6 used a combination of polyesters within the scope of the Claims 12 and 13. The physical properties of Compositions 4-6 were in all cases significantly superior to Compositions 1-3. See in particular, mar resistance, tree resin resistance, sulfuric acid etch resistance, and solvent resistance (FAM test). Duecoffre certainly does not teach or suggest that such surprising improved physical properties can be obtained with Applicants' invention.

The Examiner respectfully disagrees with this argument. The data shown in Applicants' Table 1 is irrelevant because in contrast to Applicants comparative examples 1-3, a binder of Duecoffre does have both claimed component (a) and claimed component (b). Moreover, a coating of Duecoffre would have the same properties as in claimed invention, since it is made from a coating composition substantially identical to that of claimed invention.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is 571-272-1429. The examiner can normally be reached on Monday-Friday, 9:00AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy, Ph.D.
Primary Examiner
Art Unit 1792

February 9, 2008

/Elena Tsoy /

Primary Examiner, Art Unit 1792